

REMARKS

INFORMATION DISCLOSURE STATEMENT

Applicant acknowledges the Examiner's request that copies of the references listed on the Information Disclosure Statement filed January 5, 2005 be submitted. Applicant has attached copies of the so-listed references, along with a new PTO Form 1449.

THE DOUBLE PATENTING REJECTIONS

(i) **The Rejections Based on U.S. Patent No. 6,594,044 (the '044 Patent)**

Claims 1-4, 7-15 and 29-41 were rejected under the judicially created doctrine of obviousness-type double patenting (so-called "non-statutory" double patenting") as being unpatentable over claims 1-24 of the '044 which is assigned to the same assignee as the present application, Lucent Technologies Inc.

Applicant respectfully disagrees and traverses this rejection for at least the following reasons.

A proper, non-statutory double patenting rejection must be based on the fact that the claims in the present application are not patentably distinct over the claims in a commonly owned patent which names the same (or different) inventive entity. Applicant respectfully submits that this requirement is not met.

As acknowledged by the Examiner, the claims in the '044 Patent do not include a port "configured to support at least one transport level overhead

message." Instead, the claims in the '044 Patent are aimed at the use of an out of band channel by leader or non-leader network elements.

In addition, the specification of the '044 Patent does not appear to disclose or suggest such a feature. Realizing this, the Examiner appears to rely on either his own knowledge or so-called common knowledge to reject the claims based on obviousness. The Examiner does so, however, without setting forth a Declaration or Affidavit which sets forth facts supporting such a position (see MPEP 2144.03(c), etc.).

Accordingly, Applicant respectfully requests that the Examiner present such a Declaration or withdraw these rejections and allow each of claims 1-4, 7-15 and 29-41.

In sum, Applicant respectfully submits that claims 1-4, 7-15 and 29-41 are patentably distinct over claims 1-24 of the '044 Patent, and respectfully requests that the Examiner withdraw the rejections based on the non-statutory double patenting.

(ii.) The Rejections Based on U.S. Patent No. 6,735,215 (the '215 Patent)

Claims 1-4, 7-15 and 29-41 were rejected based on non-statutory double patenting in view of claims 1-10 and 15-18 of the '215 Patent. In addition, these claims were similarly rejected in view of claims 11-14 and 9-22 of the '215 Patent.

Applicant has submitted a terminal disclaimer (attached) in accordance with 37 C.F.R. 1.321 (see attached).

Accordingly, Applicant respectfully submits that the non-statutory double patenting rejections are now moot.

Accordingly, Applicant respectfully requests withdrawal of the pending rejections and allowance of the claims.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John E. Curtin at the telephone number of the undersigned below.

In the event this Response does not place the present application in condition for allowance, applicant requests the Examiner to contact the undersigned at (703) 668-8000 to schedule a personal interview.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, Dickey, & PIERCE, P.L.C.

By

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